

REMARKS

This responds to the Office Action dated September 6, 2006.

Claims 1, 11, and 19-21 are amended; claim 23 is canceled; and claims 24-28 are added. Claims 15-18 have been previously canceled without prejudice or disclaimer. As a result, claims 1-14, 19-22, and 24-28 are now pending in this application. The amendments and additions to the claims are fully supported by the specification, as originally filed, and no new matter has been added. Applicant hereby respectfully requests further examination and reconsideration of the application in view of the following remarks.

§112 Rejection of the Claims

Claim 19 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While not admitting that claim 19 was indefinite as previously presented, in the spirit of moving forward the prosecution of the present application, Applicant has amended claim 19 to remove reference to an interference fit. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 19.

§102 Rejection of the Claims

Claims 1, 4, 5, 8-11, 13, and 19 were rejected under 35 U.S.C. § 102(a) and (e) for anticipation by Carter et al. (U.S. Patent Application Publication No. 2002/0067954). As an initial note, Applicant reserves the right to swear behind this § 102(a) and § 102(e) reference as permitted under 37 C.F.R. § 1.131. Nonetheless, Applicant respectfully traverses the rejection for at least the following reasons.

With respect to claims 1, 11, and 19, the rejection states that Carter et al. discloses a number of pipe engaging elements that “are removable from the base unit and interchangeable (see figure 2 numerals 56 and 52 and column 3 paragraph [0054]) in multiple positions along a length of the base unit (wherein 56 and 52 are multiple positions along the length of the base unit).” (See Office Action, pages 3 and 4.) With respect to claims 1 and 11, the Office Action goes on to state in the Response to Arguments section that “as pieces 52 and 56 are in two

different positions along the length of the base unit, the pipe engaging elements are removeable and interchangeable in multiple positions along a length of the base unit.” (See Office Action, page 7.)

Applicant cannot find in Carter et al. each and every element of claims 1 and 11. Carter et al. appears to show scoring wheels 52 and blades 56 that are removably engaged within scoring wheel slots 192 and blade holding slots 184, respectively, within a mole 40 for replacement due to excessive wear (*see* Carter et al., page 3, paragraphs [0053] and [0054], and Fig. 2). That is, Carter et al. appears to disclose discrete scoring wheel slots 192 in which worn scoring wheels 52 are replaced with other scoring wheels 52 and discrete blade holding slots 184 in which worn blades 56 are replaced with other blades 56, such that the mole 40 includes only one configuration of pipe engaging elements. In contrast, claim 1, as amended, recites a number of pipe engaging elements that are removable from the base unit and interchangeable in multiple positions along a length of the base unit, **including a first configuration in which a first pipe engaging element is positioned between the retention feature and a second pipe engaging element and a second configuration in which the second pipe engaging element is positioned between the retention feature and the first pipe engaging element**, and claim 11, as amended, recites a number of pipe engaging elements that are removable from the base unit and interchangeable in multiple positions along a length of the base unit, **including at least first and second configurations, the first configuration having a first pipe engaging element positioned between the retention feature and a second pipe engaging element and the second configuration having the second pipe engaging element positioned between the retention feature and the first pipe engaging element**. Support for these amendments can be found in Applicant’s specification in general, and at least on page 3, lines 11-28.

Applicant cannot find in Carter et al. each and every element of claim 19. As stated above, Carter et al. appears to show scoring wheels 52 and blades 56 that are removably engaged within scoring wheel slots 192 and blade holding slots 184, respectively, within a mole 40 for replacement due to excessive wear (*see* Carter et al., page 3, paragraphs [0053] and [0054], and Fig. 2). However, Carter et al. does not appear to show a number of pipe engaging elements wherein the pipe engaging elements are retained on the base unit by the retention feature **with a first pipe engaging element abutting the retention feature and a second pipe engaging**

element abutting the first pipe engaging element, as is recited in claim 19, as amended.

Support for this amendment can be found in Applicant's specification in general, and at least on page 3, lines 11-28; page 5, lines 20-25; and Fig. 6.

For at least these reasons, Applicant respectfully asserts that claims 1, 11, and 19 are not anticipated by Carter et al. and requests reconsideration and withdrawal of the rejection of claims 1, 11, and 19.

Dependent claims 4, 5, and 8-10 depend from independent claim 1 and dependent claim 13 depends from independent claim 11, and accordingly incorporate the features of claims 1 and 11, respectively. These dependent claims are accordingly believed to be patentable for the reasons stated herein. For brevity, Applicant defers (but reserves the right to present) further remarks, such as concerning any dependent claims, which are believed separately patentable. Thus, Applicant respectfully requests reversal of this rejection and allowance of these claims.

§103 Rejection of the Claims

Claims 7, 12, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter et al. in view of Lincoln (U.S. Patent No. 6,109,832). Applicant respectfully submits that the combination of Carter and Lincoln fails to cure the 35 USC § 102 rejection for at least the reasons outlined above.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims 1 and 11, from which claims 7, 12, and 14 depend, a 35 USC § 103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to claims 7, 12, and 14.

Claims 21 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter et al. in view of Lumpp et al. (U.S. Patent No. 4,247,163). Applicant respectfully traverses the rejection for at least the following reasons.

Applicant has amended claim 21 to include the subject matter of claim 23, which the Office Action indicated is allowable. Therefore, based upon at least the addition of the subject matter of claim 23, Applicant respectfully submits that claim 21 is now in condition for allowance and requests reconsideration and withdrawal of the rejection of claims 21 and 22.

Allowable Subject Matter

Claims 2, 3, 6, 20, and 23 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to claims 2, 3, 6, and 20, for at least the reasons stated above, Applicant believes claim 1, from which claims 2, 3, and 6 depend, and claim 19, from which claim 20 depends are in condition for allowance. Accordingly, Applicant respectfully submits that claims 2, 3, 6, and 20 are similarly in condition for allowance, at least due to their dependence from claims 1 and 11.

With respect to claim 23, as stated above, Applicant has amended claim 21 to include the subject matter of claim 23, in essence rewriting claim 23 in independent form as amended claim 21. Therefore, Applicant respectfully submits that claim 21 is in condition for allowance and such action is respectfully requested. It is noted that, because the subject matter of claim 23 was incorporated into claim 21, Applicant has canceled claim 23.

As stated above, the Office Action indicated that claim 6 would be allowable if rewritten in independent form. Applicant has presented new claim 24, which includes elements similar to those of claim 6 rewritten in independent form. Accordingly, Applicant respectfully requests allowance of claim 24 and claims 25-28 depending therefrom.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3275 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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Date October 12, 2006

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of October 2006.

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